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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,289	08/28/2003	Bradley D. Schweigert	KMC-598	6682

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicati n No. 10/650,289	Applicant(s) SCHWEIGERT ET AL.	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims the use of toe-up factor but does not disclose what the toe-up factor is. Applicant is urged to make of record what the toe factor is and why its contribution to the invention is critical.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimaru (JP 2001-037928).

Regarding claim 1, Fujimaru discloses a putter having a club head body having a toe region, a heel region, a sole, and a top surface opposite the sole, a hosel coupled to the top surface and configured to accept a shaft, wherein the club head body has a toe

Art Unit: 3711

thickness defined by a distance between the top surface and the sole in the toe region and a heel thickness defined by a distance between the top surface and the sole in the heel region (See Figure 2). The toe thickness is greater than the heel thickness, as shown in Figure 2, and the heel region is weight-compensated to substantially balance with the toe region as shown in Figure 1 (See Entire Document).

Regarding claim 7, in the broadest reasonable interpretation, Fujimaru discloses the final product in which the applicant claims. Therefore, it is submitted that the club head body as shown in figures 1 and 2, have a first cut-out having a first depth and a heel cut out having a second depth wherein the first depth is greater than the second depth.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimaru (JP 2001-037928).

Regarding claims 3 and 4, Applicant recites on page 4, paragraph 0018

“Top surface 130 may be of any suitable shape, width, and length. . . . The present invention, however, is not so limited, and contemplates any suitable club head shape.”

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a concave top surface.

Art Unit: 3711

Applicant has not set forth that having a concave top surface provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally as well with the top surface of Fujimaru because it provides a means to which the hosel may be coupled to the club head body.

Regarding claim 5, though Fujimaru does not explicitly disclose the toe-up factor being 1.20 to 1.40, one having ordinary skill in the art would have recognized that Fujimaru inherently has a toe-up factor being that the drawings show the heel region being less than the toe region and that any factor may be multiplied to the thickness of the heel region such that the value equals that of the toe region. Furthermore, applicant does not disclose why the values of the toe-up factor are critical in order to attain the invention; therefore, one having ordinary skill would have found it obvious to have the toe-up factor of any value so long as the invention is attained (See *Gardner v. TEC Systems, Inc., et al.* 220 USPQ 777).

Regarding claim 6, Fujimaru discloses the heel region weight compensated such that the center of gravity of the club head body lies in the heel region (See Entire Document). One having ordinary skill in the art would have drawn therefrom that the center of gravity may be at any location so long as the invention is attained and therefore, would have seen the location of the center of gravity being obvious.

Claims 2 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimaru (JP 2001-037928) in view of Murphy (USPN 3819180).

Art Unit: 3711

Regarding claims 2, 8, and 12, Fujimaru discloses a putter having a club head body having a toe region, a heel region, a sole, and a top surface opposite the sole, a hosel coupled to the top surface and configured to accept a shaft, wherein the club head body has a toe thickness defined by a distance between the top surface and the sole in the toe region and a heel thickness defined by a distance between the top surface and the sole in the heel region (See Figure 2). The toe thickness is greater than the heel thickness, as shown in Figure 2, and the heel region is weight-compensated to substantially balance with the toe region as shown in Figure 1 (See Entire Document). Fujimaru does not disclose the hosel being located at substantially the midpoint between the toe region and the heel region. Murphy discloses a putter having a hosel located at substantially the midpoint between the toe region and the heel region (See Figure 1 and Column 4, lines 42 through 52). One having ordinary skill in the art would have found it obvious to have the hosel located at the midpoint of the club head body, as taught by Murphy, to minimize the tendency to turn or twist during a stroke. It should be noted that applicant uses the term "hosel" to define any attachment means such as a bore (See Column 3, paragraph 0014 of applicant's specification).

Regarding claims 9 and 10, Applicant recites on page 4, paragraph 0018

"Top surface 130 may be of any suitable shape, width, and length. . . . The present invention, however, is not so limited, and contemplates any suitable club head shape."

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a concave top surface. Applicant has not set forth that having a concave top surface provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art,

Art Unit: 3711

furthermore, would have expected Applicant's invention to perform equally as well with the top surface of Fujimaru because it provides a means to which the hosel may be coupled to the club head body.

Regarding claim 11, though Fujimaru does not explicitly disclose the toe-up factor being 1.20 to 1.40, one having ordinary skill in the art would have recognized that Fujimaru inherently has a toe-up factor being that the drawings show the heel region being less than the toe region and that any factor may be multiplied to the thickness of the heel region such that the value equals that of the toe region. Furthermore, applicant does not disclose why the values of the toe-up factor are critical in order to attain the invention; therefore, one having ordinary skill would have found it obvious to have the toe-up factor of any value so long as the invention is attained (See *Gardner v. TEC Systems, Inc., et al.* 220 USPQ 777).

Regarding claim 13, Fujimaru discloses the heel region weight compensated such that the center of gravity of the club head body lies in the heel region (See Entire Document). One having ordinary skill in the art would have drawn therefrom that the center of gravity may be at any location so long as the invention is attained and therefore, would have seen the location of the center of gravity being obvious.

Regarding claim 14, in the broadest reasonable interpretation, Fujimaru discloses the final product in which the applicant claims. Therefore, it is submitted that the club head body as shown in figures 1 and 2, have a first cut-out having a first depth and a heel cut out having a second depth wherein the first depth is greater than the second depth.



Art Unit: 3711

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.

  
Sebastiano Passaniti  
Primary Examiner